

## **REMARKS**

Reexamination and reconsideration are respectfully requested in light of the above amendments and the following remarks.

### **1. Status of the Claims**

The status of the claims upon entry of the present amendments stands as follows:

**Pending Claims:** 1-15

**Rejected Claims:** 1-15

**Amended Claims:** 1, 9, and 15

**Canceled Claims:** 5-6 and 12-13

Applicants note that the present claim amendments are based on the claims as of August 5, 2010.<sup>1</sup> Applicants believe that the present amendments fully comply with 37 C.F.R. § 1.121.

### **2. Support for the Amendments**

Support for the amendments of claims 1, 9, and 15 can be found at least from (1) the originally filed claims 5-6 and 12-13 (now canceled); (2) lines 10-21 at page 6 and paragraph bridging pages 6-7 of the Specification<sup>2</sup>; and (3) the Examples, and Tables 1-3 therein. Applicants submit that the amendments introduce no prohibited new matter and are fully supported by the Specification as filed.

The claims have been amended without prejudice to, or disclaimer of, the canceled subject matter. Applicants reserve the right to file a continuation or divisional application on any subject matter canceled by way of amendment.

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<sup>1</sup> The Advisory Action mailed February 28, 2011 states that the Amendment / Response filed February 14, 2011 "will be entered"... "*for purposes of appeal*." Instead of filing a Notice of Appeal and an Appeal Brief, Applicants file the present Amendment / Response with an RCE.

<sup>2</sup> "Therefore, the present inventors have further intensively investigated, and as a result they have found that by allowing the distilled liquor to contain acetic acid in an amount within a specific range, it is possible to almost perfectly mask the odor of extract of maca contained in the distilled liquor. In this case, the acetic acid content of the distilled liquor is preferably in the range of 1 to 400 ppm with respect to the amount of pure alcohol contained therein. If the acetic acid content is less than 1 ppm, it is not possible to mask the odor of extract of maca. On the other hand, if the acetic acid content exceeds 400 ppm, it is possible to mask the odor of extract of maca but ease of drinking is impaired."

"As for herb extract, various herb extracts can be used. Among them, by adding rose hip extract to the maca extract-containing alcoholic beverage according to the present invention, it is possible to further mask the odor of extract of maca. As such rose hip extract, spirits containing rose hip extract is preferably added. Further, in the case where grape spirits and spirits containing rose hip extract are added together, they synergize to enhance the effect of masking the odor of extract of maca."

**4. Rejection of the Claims Under 35 U.S.C. § 103(a)**

**4.1 *Outstanding Rejections***

Claims 1-6, 9-13, and 15 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over **Suntory News Release No. 8691** (“Suntory8691”) in view of **Herraiz et al.**, 38 J. AGRIC. FOOD CHEM. 1540 (1990) (“Herraiz”).

Claim 7 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over **Suntory8691** in view of **Herraiz**, and further in view of **Ogawa et al.** JP 2004-000171 (“Ogawa”).

Claims 8 and 14 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over **Suntory8691** in view of **Herraiz**, and further in view of **Gonzales et al.** US Pub. 2006/0147600 (“Gonzales”).

Each of the independent claims 1, 9, and 15 thus stands rejected under 35 U.S.C. § 103(a), premised at least on the combination of Suntory8691 and Herraiz.

**4.2 *The Claims***

Claim 1 as amended, and claims 2-4 and 7-8 dependent thereon, are generally directed to maca extract-containing alcoholic beverages comprising:

an extract of maca;

a distilled liquor mainly made from fermented muscat grapes, and

a spirit containing an extract of rose hip,

wherein the distilled liquor contains 1 to 400 ppm of acetic acid with respect to the amount of pure alcohol contained therein, and wherein the maca extract-containing alcoholic beverage has a decreased odor of the maca extract.

Claim 9 as amended, and claims 10-11 and 14 dependent thereon, are generally directed to methods for decreasing an odor of maca in a maca extract-containing alcoholic beverage, comprising:

adding to an extract of maca (a) a distilled liquor mainly made from fermented muscat grapes, and (b) a spirit containing an extract of rose hip,

wherein the odor of the alcoholic beverage comes from the maca extract, and wherein the distilled liquor contains 1 to 400 ppm of acetic acid with respect to the amount of pure alcohol contained therein.

Claim 15 as amended is generally directed to methods for manufacturing a maca extract-containing alcoholic beverage having a decreased odor of maca comprising: adding to an extract of maca (a) a distilled liquor mainly made from fermented muscat grapes and containing 1 to 400 ppm of acetic acid with respect to the amount of pure alcohol contained therein; and (b) a spirit containing an extract of rose hip, wherein the maca extract-containing alcoholic beverage has a decreased odor of the maca extract.

#### 4.3 *The Office's Factual Findings*

Suntory8691 allegedly teaches a liquor product in which maca and rose hips are infused in Andes white grape distilled spirits and finished with lime and lemon juice. The Office admits that Suntory8691 does not teach or suggest Muscat grapes. The Office alleges however that (1) Muscat grapes are “known to be used in the art”; and (2) Herraiz discloses Pisco, a beverage obtained by distillation of wine made from Muscat grapes is described as being “considered a high-quality product.” The Office also alleges that based on Table 1 in Herraiz, Pisco intrinsically possesses an acetic acid content of 100 mg/l (100 ppm) of absolute ethanol. The Office then concludes that it would have been obvious to one of ordinary skill to use Muscat grapes in the liquor of Suntory8691 to produce a high-quality beverage. The Office acknowledges that Suntory8691 in view of Herraiz does not disclose masking or minimizing odor of maca, but alleges that Suntory8691 in view of Herraiz contains identical components as those presently claimed and would naturally decrease the odor of maca extract in the beverage. Ogawa allegedly teaches extracting maca with ethanol at 25°C or 40°C. Gonzales allegedly teaches a carbonated beverage containing maca.

#### 4.4 *The Law of Obviousness*

Applicants respectfully submit that the Office’s *prima facie* case does not meet the legal standards for obviousness. To properly reach a legal conclusion of obviousness, the Office must first make the factual inquiries required by *Graham v. John Deere Co.*, 383 U.S. 1 (1966). In particular the Office must:

- (a) determine the scope and content of the prior art;
- (b) determine the level of ordinary skill in the art;
- (c) ascertain the differences between the claimed invention and the prior art; and
- (d) evaluate objective evidence of nonobviousness.

Finally, the Office must articulate some rationale for why the claimed invention would have been obvious<sup>3</sup> to the ordinarily skilled artisan at the time the invention was made. *See e.g.* M.P.E.P. § 2141 (citing *KSR v. Teleflex*, 550 U.S. 398 (2007)).

Rationales that may support a conclusion of obviousness include (emphasis added below):

- (1) Combining prior art elements according to known methods to yield *predictable results*;
- (2) Simply substituting one known element for another to obtain *predictable results*;
- (3) Using a known technique to improve similar methods, or products in the same way;
- (4) Applying a known technique to a known method, or product that is ready for improvement to yield *predictable results*;
- (5) Choosing from a finite number of *identified, predictable solutions*, with a reasonable expectation of success;
- (6) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces *if the variations are predictable* to one of ordinary skill in the art;
- (7) Identifying some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the *claimed* invention.

*See also Examination Guidelines for Determining Obviousness under 35 U.S.C. 103 In View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc., 72 Fed. Reg. 57,528 (Oct. 10, 2007).*

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<sup>3</sup> Of course, the asserted references or combination of references also must teach or suggest every limitation of the claims.

#### *4.5 Applicants' Claims are Patentable*

Applicants respectfully traverse. The presently claimed product and method are nonobvious for at least the following reasons. First, the Office erroneously applies one or more of the factual determinations required under *Graham*. Second, there would have been no motivation to combine the references in the manner proposed by the Office. Finally, there is no proper rationale for combining the references or the arriving at the ultimate conclusion of obviousness has been articulated by the Office. Moreover, contrary to assertions in the Office Action, Applicants' Specification plainly provides unexpected results regarding decreasing or masking the maca odor. Thus, the claims as amended are patentable over the asserted references.

*A. The Office's determinations under at least Graham factors (a) and (c) above are erroneous.*

Assuming *arguendo* that there was some rationale or motivation to combine the references, the Office has not properly determined the *scope* of the prior art, i.e. the first *Graham* factor. In particular, the Office concludes that "Pisco" intrinsically contains acetic acid at 100 mg/l. Applicants disagree. First, Herraiz provides a skilled artisan with no information whatsoever regarding how to make, use, or select a Pisco with the reported content (i.e., containing acetic acid at 100 mg/l). As Applicants have previously noted to the Office, Herraiz teaches that "the alcohol content of Pisco as well as its volatile composition may vary broadly" (*see* Introduction). Moreover, Herraiz does not identify either the type of Pisco or a source of the Pisco used, except to say that "Chilean Pisco" was used (*see* Experimental Procedures). In fact, notwithstanding the general disclosures in Herraiz, there is nothing in the reference to even confirm that the Chilean Pisco selected for the multidimensional analysis of volatile components is even "mainly made from fermented Muscat grapes" as required by the claims.

As evidenced by the information from the website [www.guacamayopisco.com/typesofpisco.html](http://www.guacamayopisco.com/typesofpisco.html) ("Guacomayo") (enclosed as **EXHIBIT I**), "pisco" is a broad term that encompasses a number of very different alcoholic beverages that by definition are not beverages that requires the use of mainly or even use of *any* Muscat grapes. For example, of the four types of Peruvian Pisco, only one, Aromatic (*Pisco aromatico*), is even allowed to contain Muscat grapes. Thus, Peruvian Pure Pisco (*puro*) is not made from Muscat grapes at all, but rather from Quebranta grapes, while Pisco *aromatico* is made from Muscat

grapes, Italia and Torontel grapes. As further evidenced by Guacomayo, Chilean Pisco is even less well-defined, in that while there are various grades based on the alcohol content or proof, Chilean pisco grades do not require or specify from which grapes they are made and may be prepared from, and/or include at least three types of grapes, Muscat, Torontel, and Pedro Jimenez.

Even assuming *arguendo* that the Chilean Pisco used by Herraiz was in fact “mainly made from fermented Muscat grapes” (a fact for which there is no evidence on the record), the skilled artisan has no way of knowing where or how to acquire the Pisco analyzed by Herraiz, and would not have known even to look for it to obtain the advantages of Applicants’ claimed invention. The mere use of pisco to obtain the “high quality beverage” as asserted by the Office in no way teaches, suggests, or provides any guidance to the skilled artisan to seek out a pisco mainly made from Muscat grapes and having a particular acetic acid content. The skilled artisan would not have been directed to select a brand or type of Pisco that contains the claimed level of acetic acid at all, let alone within the claimed range.

In fact, the skilled artisan cannot ascertain from Herraiz what volatile components, if any, of Pisco derive, e.g. from Muscat grapes, from other types of grapes, or from the unspecified fermentation conditions, or from the particular growing conditions in Chile in a particular year. In summary, the skilled artisan, even if motivated, as the Office alleges, to seek a high quality beverage, would not have been able to discern what Pisco to select that “intrinsically” had the desired properties, or what properties were even important to make the claimed beverage. There is nothing in Herraiz from which to conclude that all pisco, or even all Chilean Pisco inherently possesses the required acetic acid content.

Moreover, while Herraiz teaches analysis of one unnamed, undefined “Chilean Pisco” that appears to fall within the specified range of acetic acid, the skilled artisan has no basis for using *any* such Pisco as a means to create the Office’s proposed “high quality beverage.” There is no evidence on the record that the particular “Chilean Pisco” that was investigated in Herraiz would have been of “high quality.” Applicants submit that Herraiz simply does not provide a skilled artisan any reasonable expectation of success to replace the Andes white grape distilled spirits (described in Suntory 8691) with pisco. The disclosure of Herraiz lacks any information about the nature of the Pisco used, or how to make it or where to obtain it, including whether it is in fact made mainly from fermented Muscat grapes. Pisco from Chile, by law, does not identify

from which type of grape it is made, as evidenced by Guacomayo. Chilean pisco only specifies its grade by alcohol content. Herraiz does not appear to identify *either* the alcohol content or the grade of the Chilean Pisco used, further frustrating any efforts by a skilled artisan to use Herraiz in the manner suggested and required by the Office's rejection.

Given the foregoing, Applicants respectfully assert that the Office has not properly assessed the scope of the prior art, because the Office's conclusion of Herraiz vastly overstates what Herraiz actually teaches regarding any alleged intrinsic properties of pisco or its acetic acid. The Office also underestimates the futility of efforts by the skilled artisan to utilize the teachings or suggestions from Herraiz in any meaningful way to modify Suntory8691 to arrive at Applicants' claimed products and methods. Herraiz is devoid of any teaching that would have allowed the skilled artisan to build on what Herraiz teaches. Applicants respectfully submit that the Office's mischaracterization of the scope of the prior art has led to an incorrect conclusion with respect to the patentability of the claims. Accordingly, on at least that basis, Applicants request reconsideration, followed by withdrawal of the rejection with respect to all pending claims.

Applicants also respectfully assert that the Office has erred in ascertaining the *differences* between the prior art and Applicants' claims, i.e. the second *Graham* factor.

First, given the above arguments on the Herraiz reference, Applicants specifically addressed this issue in the Specification, by noting that not just *any* pisco will suffice. As Applicants' Specification states with reference to pisco:

However, the present inventors have also found that even in the case where such a distilled liquor [*i.e. pisco*] is used as a base alcohol to which an extract of maca is to be added, it is not possible to perfectly mask the odor of extract of maca. Therefore, the present inventors have further intensively investigated, and as a result they have found that by allowing the distilled liquor to contain acetic acid in an amount of within a specific range, it is possible to almost perfectly mask the odor of extract of maca contained in the distilled liquor.

Specification, lines 7-15 (bracketed text added).

As is made evident by the further disclosures of Applicants' Specification, the acetic acid must be within a specified range to mask the odor of maca, and yet not spoil the drinkability of the beverage. Such a range, within those limits, is present in the claim as originally filed, and is neither taught nor suggested by Herraiz nor Suntory8691, nor those references in combination.

Applicants respectfully assert that this is a difference between the prior art and Applicants' claims not merely of degree, but of *kind*. See, e.g. M.P.E.P. § 716.02.

Second, given Guacomayo as discussed above, the Office cannot state with any degree of certainty that Herraiz teaches the limitation of "a distilled liquor mainly made from fermented muscat grapes." This limitation is present in each of the claims which have been amended in part for consistency with respect to expressly stating this limitation. Because the Office relies solely on Herraiz for this aspect of the *prima facie* case, it should be noted that this claim limitation at least distinguishes the claimed invention from the asserted art even in combination. Thus, the Office's conclusion that "Suntory in view of Herraiz contains *identical* components as the presently claimed method and the combination of the references would naturally decrease the odor of maca extract contained in the beverage" (Office Action, pages 3 and 6) is merely speculation, particularly in view of Guacomayo. Even if the Office were correct (which it is not), there is nothing in the references themselves that would have allowed a skilled artisan at the time to *make* a combination that would naturally decrease an odor of maca, since Herraiz lacks the required teachings of which pisco to use or try. At most, the combination is an invitation to experiment – where the art does not teach or suggest anything about which variables might be important. In the absence of the roadmap provided by Applicants' Specification, there is no more reason to choose the unidentified "pisco" of Herraiz over a different distilled liquor such as whiskey, brandy, shochu, vodka, or other alcohol, including wine, all of which would present at least the same "high-quality beverage" motivation as Herraiz allegedly provides. The Office's selection of Herraiz in the absence of such reason strongly suggests *improper* hindsight reconstruction.

Third, in addition to (1) the differences noted above between the prior art and the claims with respect to "pisco", and (2) the questions as to whether the "a distilled liquor mainly made from fermented muscat grapes" is satisfied, Applicants also submit that the prior art lacks any teaching or suggestion that, as presently claimed, a maca extract-containing alcoholic beverage containing the recited distilled liquor and have the claimed level of acetic acid would have had a decreased maca odor. Applicants' Specification clearly discloses this aspect, for example in Examples 2-4, and the data clearly presented in Tables 2-3 (the addition of a spirit containing an extract of rose hip "enhance[s] the effect of masking the odor of extract of maca). It can be seen that neither the presence of distilled liquor from Muscat grapes alone (in the absence of the



claimed level of acetic acid), nor the presence of the claimed level acetic acid alone (in the presence of distilled liquor from multiple sources other than Muscat grapes) can effectively decrease the odor of maca. Further, it can be seen from Table 2 that the presence of too much acetic acid is not desirable, because although the odor-decreasing effect is still accomplished, the beverage is not palatable.

Neither Herraiz nor Suntory8691 teach or suggest the combination of a specific type of distilled liquor and a specified range of acetic acid to accomplish a odor-decreasing effect, and accordingly, in view of at least this and the comments *supra* regarding the scope of the prior art and other differences between the prior art and Applicants' claims, Applicants respectfully request reconsideration of the patentability of the claims and withdrawal of the rejection under 35 U.S.C. § 103(a).

Finally, given at least the foregoing remarks, even if the Office somehow maintains that the compositions would have been obvious at the time, a position Applicants respectfully assert is not sustainable, the presently claimed methods should nonetheless be patentable over Herraiz and Suntory8691 in any combination, because the asserted references do not in any way teach a reproducible method according to the amended claim 9. As has been acknowledged by the Office, neither reference teaches or suggests decreasing odor of maca at all. Further, neither reference teaches or suggests the previously unknown interplay between Muscat grape distillate and acetic acid in the masking effect. Accordingly, Applicants respectfully submit that no *prima facie* case has been adduced. Given the arguments presented *supra* as to the scope of the prior art and the differences between the prior art and the claims (e.g. including at least the inability of the skilled artisan to even identify the Pisco used by Herraiz and the fallacy of the Office's assertion that generically "pisco" intrinsically contains acetic acid in the amount recited in the claims), Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), with respect to all claims so rejected.

*B. The Skilled Artisan at the Time of Invention had no Motivation for Combining the References*

The Office alleges that Muscat grapes are known in the art, and that pisco is a beverage obtained by distillation of wine made from Muscat grapes, which is considered a high quality product. See Office Action, pg. 2. Therefore, according to the Office, it would have been

obvious to one of ordinary skill to use Muscat grapes in the liquor of Suntory8691 in order to produce a beverage which would be regarded as “high-quality”. *Id.*

Applicants respectfully traverse the finding that this motivation would have sufficed at the time of the invention to combine the references. As a preliminary matter, the Office has not specified what aspect(s) of modified Suntory8691 would show “high quality.” Applicants respectfully request at a minimum that this be made of record should the rejection be maintained even after entry of this response.

First, as discussed above, Herraiz teaches *nothing* about the Chilean Pisco other than its content of certain volatiles. Thus, the Office has not addressed how the skilled artisan would identify the generic “Chilean Pisco” analyzed by Herraiz, or be able to make or use it in the proposed combination. Moreover, Herraiz, as a whole, does not even state that the particular Chilean Pisco analyzed was made from Muscat grapes, or was a high-quality product. Any statements regarding the general properties of pisco on which the Office relies refer generally to pisco, and not specifically or necessarily to the particular Chilean Pisco used in Herraiz’s analysis. A skilled artisan does not know (1) what pisco was used by Herraiz; (2) what its properties or qualities are; and (3) where to obtain it, how to make it, or the like. There is simply no guidance for the skilled artisan even if he was initially motivated to do so. That lack of teaching, and lack of identification poses a significant barrier to the skilled artisan and thus s/he would not be motivated to even attempt the substitution proposed, let alone that the substitution would have been successful.

Second, the Office has not addressed why the proffered combination even presents any *likelihood* of or opportunity for improvement. According to the Office, the beverage disclosed in Suntory8691 is a liquor product “infused in Andes *white grape distilled spirits*.” The skilled artisan would not have been motivated to substitute Chilean pisco (a distilled product made from Andes grapes of various types) in the composition of Suntory8691 – for the Andes white grape distilled spirits, because NO improvement would have been expected from the simple operation of substituting one Andes white grape distilled spirit for another. This is particularly true in the absence of any asserted difference in quality traits between Suntory8691 and Herraiz or the proposed modified Suntory8691. Again, the Office has not provided what attributes or parameters of quality would have been expected to be or sought to be improved. The Office has also failed to identify any *real* advantage of making the substitution of one distillate of Andes

white grapes (as used in Suntory8691) for another (the pisco analyzed by Herraiz). The only advantage comes from the hindsight recognition provided by the Applicants' Specification.

Additionally, the Office has provided no basis or reason for selecting the Herraiz reference or why the skilled artisan would choose *that particular* distilled spirit to make a "high-quality beverage" instead of any one of the many other types of distilled alcoholic beverages, such as brandy, whiskey, gin, vodka, tequila or the like. All of the foregoing are certainly available as "high quality" products and would make equally logical substitutions for the distilled spirits of Suntory8691. Because there is nothing in Suntory8691 to suggest quality issues or some need for improvement, and because neither reference teaches or suggests any particular advantage to be obtained from the combination, as Applicants' have previously addressed, the motivation comes solely from an *impermissible* hindsight reconstruction.

The Office argues that any judgment on obviousness necessarily is, in a sense, a reconstruction based on hindsight reasoning, but that as long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention and does not include knowledge gleaned only from Applicants' disclosure, such a reconstruction is proper. *See* Office Action, pages 6-7. Here, however, there is nothing that teaches or suggests *any* need for improvement in Suntory8691. There is nothing outside of Applicants' disclosure that teaches or suggests the use of pisco or any other distilled spirits from Andes white wine grapes generally or Muscat grapes in particular, let alone the recited level of acetic acid contained therein. And there is nothing outside of Applicants' Specification that at the time, would have directed the skilled artisan to select Herraiz over references teaching other distilled spirits, such as brandy, whiskey, shochu, gin, rye, scotch, vodka, or the like.

The Applicants' disclosure, and only the Applicants' disclosure, leads to the selection of Herraiz, and to the proposed combination of Herraiz and Suntory8691. Despite the fact that Suntory8691 makes no mention of a need for improving quality<sup>4</sup>, the Office's suggested "motivation" is premised on making a "high-quality beverage". But, there is no basis in the references themselves, or in the art as a whole at the time for the proposed combination for any purpose, let alone to arrive at the claimed product and/or method with an expectation of success. Applicants note that they do not argue that the motivation asserted by the Office must be the same as that used by the inventors, here the Office has not articulated any motivation that arises

independent of Applicants' disclosure other than to generically claim the skilled artisan would have sought a "high-quality beverage".

Given the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections under 35 U.S.C. § 103(a).

*C. Applicants' Invention Produced Unexpected Results that Could Not Be Predicted and Were Not Known in the Art*

Notwithstanding all of the foregoing reasons why Applicants' claims are patentable over the asserted art, Applicants also respectfully submit that the Specification as filed plainly shows unexpected results. The Office Action states, in addressing the amount of maca in the extract, that the specification is silent with respect to unexpected results, and that in the absence of unexpected results, the claimed amount cannot be considered critical. In fact, with respect to the masking effect as a result of the presence of the claimed combination of distilled spirits from Muscat grapes and a specific claimed range of acetic acid, Applicants' Specification exemplifies unexpected results.

As most clearly shown in the Examples and Table 2, no distilled spirits, other than distilled spirits mainly made from Muscat grapes, were able to work to decrease or mask the odor of maca in the beverage. This result was completely unexpected – it could not have been predicted, and was not known in the art at the time. Additionally, even distilled spirits made from Muscat grapes were not able to mask the odor in the absence of a minimum amount of acetic acid. As the Specification notes, only after intensive investigation were the inventors able to determine the need for acetic acid at this minimum amount, as well as a maximum amount beyond which the palatability of the beverage was not acceptable. These unexpected results are described in the Specification as filed (see e.g., Applicants' Specification at page 6, lines 29-35 through page 7, lines 10), and exemplified therein.

There was nothing in the references or in the art as a whole at the time that would have made such results "expected." The skilled artisan at the time could not have predicted that the odor of maca could be masked by the combination of a Muscat grape distilled spirit and acetic acid in the claimed range. Accordingly, Applicants respectfully request reconsideration of the

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<sup>4</sup> The Office has not stated any basis as to why or whether the Suntory8691 beverage needs to "improved" in any manner, nor does the Office allege that Suntory8691 is not already high-quality.

patentability on the basis of the demonstrated unexpected results, and withdrawal of the rejection on that basis.

D. *The Office's Articulated Rationale for Concluding the Claimed Invention Would Have Been Obvious is Legally Insufficient*

As noted above, the Office has articulated that the skilled artisan would have been motivated to modify Suntory8691 using the pisco of Herraiz because of the desire to produce a high-quality beverage. Even assuming *arguendo*, that there would have been sufficient motivation to combine the references at the time, a point Applicants disagree with as asserted above, here the stated rationale is insufficient to conclude the claims are not patentable. The Office's asserted rationale does not comport with any of the recognized rationales for allowing a conclusion of obviousness (cited in section 4.4, *supra*).

Applicants are of the view that the Office has asserted essentially only a single rationale for reaching its conclusion of obviousness. The Office alleges that the skilled artisan at the time would have been motivated to combine Herraiz with Suntory8691 as follows: the pisco "taught" by Herraiz would be substituted in the beverage disclosed in Suntory8691 in seeking a high-quality beverage because Muscat grapes are allegedly known to be widely used in the art. The so-modified Suntory8691 beverage, according to the Office, would possess the claimed composition and would naturally reduce the odor of maca.

The Office has not attempted to argue that the skilled artisan could have used a known technique of removing maca odor in the same way, or that the skilled artisan would have been seeking the predictable results of combining known elements, or methods. The Office has not alleged that the possible choices of improving Suntory8691 to make a high-quality beverage would provide a finite number of predictable solutions with any reasonable expectation of success.

Moreover, the Office has not alleged any rationale that comes close to satisfying the requirements for the ultimate legal conclusion of obviousness. Even if the claimed product and/or method were merely the combination of old elements, there was nothing predictable about the combination. Here, the claimed product and/or method are much more than the predictable combination of old elements, as they were not known until Applicants' discovery that a

combination of distilled product from fermented Muscat grapes, together with a specific range of acetic acid, could mask the odor of maca.

To the extent the Office is relying on market forces as a predicate for the motivation to seek a high-quality beverage, Applicants respectfully note that as a rationale for concluding obvious, requires that the market forces lead to a predictable solution. As the Supreme Court has stated:

When a work is available in one field, design incentives and other market forces can prompt variations of it, either in the same field or in another. If a person of ordinary skill in the art can implement a *predictable variation*, and would see the benefit of doing so, §103 likely bars its patentability.

*KSR v. Teleflex*, 550 U.S. 398 (2007) (emphasis added)

Here, such market forces, including any desirability for a high-quality beverage cannot be a sufficient rationale for a conclusion of obviousness because the result of masking odor was not predictable at the time, and as Applicants have discussed at length above, was not in any way intrinsic or a natural result of the asserted combination. Accordingly, the Applicants' claims must be found patentable. Claims 4-5 and 12-13 are canceled, mooted the rejection. Applicant's respectfully request reconsideration and withdrawal of the rejections on this basis as well.

### **CONCLUSION**

In view of the above arguments and amendments to the claims, Applicant submits that the claims are in condition for allowance and respectfully request reconsideration and timely allowance of the claims.

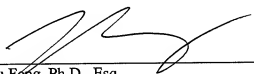
Should the Examiner have any questions or comments regarding Applicants' amendments or response, please contact Applicants' undersigned representative at (202) 230-5119. Furthermore, please direct all correspondence to the below-listed address.

In the event that the Office believes that there are fees outstanding in the above-referenced matter and for purposes of maintaining pendency of the application, or for Notice of Appeal, the Office is authorized to charge the outstanding fees to Deposit Account No. 50-0573. The Office is likewise authorized to credit any overpayment to the same Deposit Account Number.

Respectfully Submitted,

Date: April 8, 2011

By: \_\_\_\_\_

  
Zhengyu Feng, Ph.D., Esq.  
Registration No. 66,816

**DRINKER BIDDLE & REATH LLP**

Customer No. **55694**

1500 K Street, N.W., Suite 1100

Washington, D.C. 20005-1209

Tel. No.: (202) 842-8800

Fax No.: (202) 204-0289

## **EXHIBIT I**

GUACOMAYO® Pisco Puro (Peruvian Pisco Puro), *available at*

<http://www.guacamayopisco.com/typesofpisco.html>



# GUACAMAYO® Pisco Puro

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## Varieties

### Early Production

The black grape taken to Peru by the Spanish suffered due to its adaptation to soil and weather conditions in the Province of Pisco, eventually stabilizing in a new variety named "Quebranta", purportedly named because the original grape was "broken" (Spanish *quebrar*), or tamed, for its new environment. Almost all early pisco was produced from this variety of grape, others used any grape available at the time. However, since only the largest (and those with dedicated pisco distilleries) vineyards were able to produce exportable volume, Quebranta was the only variety exported, since it was the preferred grape for pisco production.

### Peruvian Pisco

In the years following the re-establishment of pisco production, many grapes were used to produce pisco, leading to a wide variation in flavor, aroma, viscosity and appearance of the licor. This harmed attempts to export the product under a single denomination since there could be enormous differences between the contents of bottles sold as pisco. As such, a number of regulations were established to counteract this situation and set a baseline for a product to carry the name.

Four levels of pisco were thus designated:

**Pure**, made from a single variety of grape, mostly Quebranta, although Mollar or Common Black can be used, however, no blending between varieties is accepted, "Pure" Pisco should contain only one variety of grape.

**Aromatic**, made from Muscat or Muscat-derived grape varieties, and also from Italia and Torontel grapes varieties; once again, the pisco should only contain one variety of grape in any production lot.

**Green Must**, distilled from partially fermented must, this must be distilled *before* the fermentation process has transformed sugars into alcohol.

**Acholado (Half-breeded)**, blended from the must of several varieties of grape.

The order is not established on quality, it is simply listed in that way in Peruvian publications. Some other specific restrictions of note are:

**Aging**, Pisco must be aged for a minimum of three months in vessels of "glass, stainless steel or any other material which does not alter its physical, chemical or organic properties".

**Additives**, no additives of any kind may be added to the Pisco that could alter its flavor, odor, appearance or gradulation.

Pure pisco is a very viscous liquid, slightly more so than vodka and comparable to Sambuca. It has an odor which is vaguely reminiscent of reeds. Its flavor is very smooth and almost non-alcoholic, which can be very deceptive, with the result that many first-time drinkers often overdrink and can quickly become inebriated without noticing. Some people consider it heresy to mix pure pisco with anything else, and it is generally accepted that it should be drunk alone, even to the exclusion of ice.

Aromatic is rarely seen nowadays, as its production has almost ceased in Peru, since according to Peruvian specifications. Chilean pisco would be classified as Aromatic. See the Chilean pisco section for more information.

Green Must is accepted as a poor man's pisco, not generally seen in high-income environments. Its taste is very strong, as is its odor, and can be quite pungent if left to breathe for a large amount of time.

Acholado is gaining popularity due to its sweetness, both in odor and flavor, making it a favorite for Pisco sour, a mixed drink. The Acholado variety is also preferred due to its "kick", which can be felt immediately after drinking, one can literally feel the drink making its way to the stomach.

### Chilean Pisco

During the adaptation of many vineyards to Pisco production, the most widespread grape was used as raw material, namely the Muscat, with some vineyards preferring the Torontel and Pedro Jiménez varieties. As is the case with Peru, regulations for Pisco

designations have been enacted in Chile:

- **Regular**, 30° to 35° (60 to 70 proof).
- **Special**, 35° to 40° (70 to 80 proof).
- **Reserve**, 40° to 43° (80 to 86 proof).
- **Great**, 43° or more (86 or more proof).

No distinction between varietal mixes is made other than it is restricted to the three kinds of grapes named before. It should be noted that, different to the Peruvian Pisco, during the production water is added to the Chilean Pisco in order to soft the 'firewater' aftertaste.

Regular Pisco is quite bland in taste, reminiscent of a weak rum, and its odor is very sweet and woody with a slight yellowish tinge to the color.

Special and Reserve are very similar in flavor and color, both being very sweet and of a cloudy yellowish color. The flavor is much stronger than Regular Pisco and leaves an alcoholic aftertaste in the mouth, similar to bourbon.

Great Pisco has a commanding odor and a very pleasant dark yellow color, it is not as sweet as the other varieties, yet it carries strong woody flavor the others lack, probably due to longer aging.

### Comparison

	PERU	CHILE
Definition	Firewater obtained exclusively from the distillation of recently fermented "Pisco Grapes", using methods which maintain the traditional principles of quality established in recognized production areas.	...is reserved to firewater produced and bottled, in consumable quantities, in Regions III and IV, elaborated by the distillation of genuine wine, originating from specified varieties, grown in said regions.
Grapes	Non Aromatic: Quebranta, Common Black, Mollar Aromatic: Italia, Muscat, Albilla, Torontel.	Yellow Muscat, White Early Muscat, Alexandria Muscat, Austrian Muscat, Frontignan Muscat, Hamburg Muscat, Black Muscat, Pink Muscat, Canelli Muscat, Orange Muscat, Pedro Jiménez, Torontel.
Production	The fermentation process can be done with partial or total maceration of the grape, strictly controlling the temperature and decomposition of sugars.	The grape juice is fermented into wine containing 14° alcohol (28 proof).
	The fermented product is distilled in copper or stainless steel recipients to the desired gradation. No product may be added to alter the gradation, odor, flavor or color of the liquid.	The fermented product is distilled in copper recipients until a gradation of 55° to 60° is reached. Rectifiers must be added if alcohol gradation is less than specified.
	The Pisco must be aged a minimum of three months in glass, stainless steel or other materials which do not alter the physical, chemical or organic properties before bottling.	The crude firewater is aged in wood recipients for a short time, usually not more than a few months. Higher quality brands may be aged in oak barrels for a longer time.
	The Pisco must be bottled directly after aging, without alteration or adding any product which could alter the odor, flavor or appearance.	The firewater from different distilleries is mixed, diluted with demineralized water in order to lower the gradation to the desired level, filtered and bottled.
Alcohol Content	38° to 48° (76 to 96 proof)	No less than 30° (60 proof)
Designated Pisco Areas	Departments of Lima, Ica, Arequipa, Moquegua and the Locumba, Sama and Caplina valleys in the Department of Tacna.	Atacama, Coquímbo.

NOTE: the Peruvian regulation specifically refers to "Pisco" throughout the document; the Chilean regulation mentions it as *aguardiente* (brandy or "firewater") when referring to Pisco in general and only mentions "Pisco" when referring to a specific variety (such as "Reserve Pisco").